

REMARKS

Claim 23 is canceled. New claims 26-28 are added. Support for the new claims is provided by at least the originally-filed application at, for example, Figs. 1-7.

Examiner states that the listing of the references in the specification is not a proper information disclosure statement since the German language references listed on page 2 of the specification were not submitted in a separate paper. However, corresponding publications of both references cited on page 2 of the specification were listed in an information disclosure statement filed January 31, 2005. U.S. Patent No. 5,737,057 and EP 0732172 are corresponding publications of DE 69606340 and both were cited on the January 31, 2005 information disclosure statement. Additionally, U.S. Patent No. 5,951,376 is a corresponding publication of DE 29723542 and was also cited on the information disclosure statement filed January 31, 2005. Furthermore, these references have been initialed by the examiner on March 27, 2007. Therefore, it is believed that the references cited on page 2 of the specification have been cited correctly. However, if additional information is needed, please do not hesitate to contact us.

Claims 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mandler (U.S. Patent No. 5,951,376) in view of Sorrells. Claims 21-25 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Sorrells (U.S. Patent No. 4,358,913).

Regarding the obviousness rejection against independent claim 16 based on the combination of Mandler and Sorrells, the Examiner, respectfully, provides a deficient motivational rationale for combining the references. The Examiner is reminded that the U.S. Supreme Court recently decided *KSR International Co. v. Teleflex Inc.* (550 U.S. ___, No. 04-1350, decided April 30, 2007), wherein the Court noted that the analysis supporting

a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

(emphasis added).

The Examiner states it would be obvious to provide the process of Mandler with the adapter taught by Sorrells to align lens without having to disconnect the lens from a first holder to shorten processing time. However, combining these teaching would not shorten processing time. The invention of Mandler is directed to processing of lens blanks **before precision processing** the lens blanks into end products. Mandler teaches to improve the coarse surfaces of the lens blanks to facilitate the accuracy of subsequently precision processing (grinding) of the lens blanks into the end products. (cols. 1-2 of Mandler). However, **Sorrells** teaches that its invention is directed to the precision processing of the end product and specifically states that the “special adapter chuck 270 employed with fining and polishing apparatus [is] utilized subsequent to the lens blank surface generation.” (emphasis added) (col. 14, lines 58-60). That is, Sorrells teaches its adapter would not even be used until the Mandler processing is finished. Logically, providing the process of Mandler with the adapter taught by Sorrells, as suggested by the Examiner, **would not shorten processing time** because the Sorrells adapter would not be used until

the Mandler processing was finished. Consequently, the motivational rationale provided by the Examiner for combining the references, to shorten processing time, does not exist. Since the Examiner has not provided a proper motivational rationale for combining the references, the obviousness rejection against claim 16 which is based on a nonexistent rationale must fail. Accordingly, independent claim 16 is allowable.

Claims 17-20 depend from allowable independent claim 16, and therefore, claims 17-20 are allowable for depending from an allowable independent claim.

For example, claim 19 recites “wherein the positioning of said first holder comprises using a collet chuck.” The Examiner states the adapter body 278 of Sorrells is a collet chuck. The Examiner is mistaken. No reasonable or fair interpretation can be presented to suggest that adapter body 278 of Sorrells is a collet chuck . A collet chuck comprises a **cone-shaped collar or sleeve** to hold a workpiece. The adapter body 278 of Sorrells does not have or suggest a cone-shaped collar. One skilled in the art understands the distinction between a collet chuck of the present invention and the adapter body 278 of Sorrells. The collet chuck greatly increases the speed of chucking relative conventional chucks. The collet chuck is self-centering, has a stronger clamping force, greater resistance to being untightened and centers on a workpiece with a higher level of precision relative conventional chucks. Therefore, in no reasonable or fair interpretation can Sorrells be stated to teach or suggest a collet chuck. Accordingly, Sorrells in combination with Mandler fails to teach or suggest “the positioning of said first holder comprises using a collet chuck” as positively recited by claim 19. Claim 19 is allowable.

Regarding the anticipation rejection against independent claim 21 based on Sorrells, claim 21 is amended to recite “an alignment reference **and a collet chuck** configured to

position said first holder relative said adapter part.” The amendment language is the language of cancelled claim 23, and therefore, no new matter is added. Sorrell does not teach or suggest a collet chuck. The Examiner states the adapter body 278 of Sorrells is a collet chuck. The Examiner is mistaken. No reasonable or fair interpretation can be presented to suggest that adapter body 278 of Sorrells is a collet chuck . A collet chuck comprises a cone-shaped collar to hold a workpiece and functions differently from the adapter body 278 of Sorrell. The adapter body 278 of Sorrells does not have a cone-shaped collar and functions as a conventional chuck. Therefore, in no reasonable or fair interpretation can Sorrells be stated to teach or suggest a collet chuck. Accordingly, Sorrells fails to teach or suggest “an alignment reference **and a collet chuck** configured to position said first holder relative said adapter part” as positively recited by claim 21. Independent claim 21 is allowable over Sorrells and since no other rejection is presented against claim 21, independent claim 21 is allowable.

Claims 21-22 and 24-25 depend from allowable independent claim 21, and therefore, are allowable for depending from an allowable independent claim.

New claim 26 recites “an alignment reference **structure extending** from a surface of the adapter part, the alignment reference structure configured to position a first holder relative the adapter part.” The Examiner relies on opening 310 of Sorrells (Figs. 21-22) to teach an alignment reference. An opening 310 does not have “structure” as positively recited by claim 26, and therefore, could not have “structure **extending from a surface** of the *adapter part*” as positively recited by new claim 26. Accordingly, new independent claim 26 is allowable.


New dependent claims 27-28 are allowable for depending from an allowable

independent claim.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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